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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,158

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Steffen Sonnenberg

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11/12/2008

ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.

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WASHINGTON,, DC 20036

EXAMINER

NATNITHITHADHA, NAVIN

ART UNIT

PAPER NUMBER

3735

MAIL DATE

DELIVERY MODE

11/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/564,158	Applicant(s) SONNENBERG ET AL.	
	Examiner NAVIN NATNITHITHADHA	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. According to the Amendment, filed 13 December 2007, the status of the claims is as follows:

Claims 1, 3, 8, and 10 are currently amended;

Claims 2, 4-7, and 9 are previously presented; and

Claims 11 are new.

2. The objections to Specification are WITHDRAWN in view of the Amendment filed on 11 January 2006, and the Amendment filed on 13 December 2007.

3. The 35 U.S.C. 112, second paragraph, rejections to claims 1-10 are WITHDRAWN in view of the Amendment filed on 13 December 2007.

4. The 35 U.S.C. 101 rejections to claim 1 is WITHDRAWN in view of the Amendment filed on 13 December 2007.

Response to Arguments

5. Applicant's arguments, see Remarks, pp. 5-6, filed 13 December 2007, with respect to the rejection of claims 1-4, 6, 8, and 9 under 35 U.S.C. 102(b) as being

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anticipated by Mottram et al, W.O. Patent No. 97/00444 ("Mottram"), have been fully considered, but are moot in view of the new ground(s) of rejection.

6. Applicant's arguments, see Remarks, p. 6, filed 13 December 2007, with respect to the rejection of claims 5 and 7 under 35 U.S.C. 102(b) as being anticipated by Mottram, have been fully considered, but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments, see Remarks, p. 6, filed 13 December 2007, with respect to the rejection of claims 10 under 35 U.S.C. 102(b) as being anticipated by Sharma et al, "the Clinical Efficacy of Colgate Total Plus Whitening Toothpaste Containing a Special Grade of Silica and Colgate Total Toothpaste for Controlling Breath Odor Twelve Hours After Toothbrushing: A Single-Use Clinical Study", The Journal of Clinical. Dentist, Bd. 13, Nr. 2, 2002, pp. 73-76 ("Sharma"), in view of Mottram, have been fully considered, but are moot in view of the new ground(s) of rejection.

Claim Objections

8. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The method of evaluating an oral care product does not further limit the method of evaluating the breath of a test subject in claim 1.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-11 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also *In re Comiskey*, 499 F.3d 1365, 1376 (Fed. Cir. 2007) (request for rehearing *en banc* pending).

Dependent claims 2-11 are rejected for the same reason as claim 1.

10. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Because claim 8, positively recites a “test subject”, which is a human or other biological entity, the claim is directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Baghdassarian et al, U.S. Patent Application Publication No. 2003/0050567 A1 (“Baghdassarian”).

Claims 1-11: Baghdassarian teaches the following:

A method of evaluating the breath of a test subject (see Abstract and figs. 1, 2, and 5), comprising the following steps:

- a) collecting a breath sample from the test subject in a container 27/33 (see para. 30-31),
- b) condensating moisture from the breath sample thereby reducing a microbial load of the breath sample contained in the container (see para. 36), and then
- c) of evaluating the breath sample collected in the container 33 (see para. 37);

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characterized in that, in step a), the container 27/33 is filled with breath by the test subject against atmospheric pressure by exhalation (see para. 38);

wherein a volume of the container 27/33 is variable (see para. 39);

characterized in that the container 27/33 possesses an internal surface made of an odourless material (see para. 39);

characterized in that the container is filled with 20 ml to 7 l of breath in step a) (see para. 30);

characterized in that the microbial load is reduced by condensation of moisture from the breath sample in the container (see para. 36);

characterized in that the temperature of the breath sample is adjusted to a value of 20°C to 40°C before performing step c) (see para. 36);

characterized in that the test subject fills the container in step a) by exhaling through the mouth (see para. 37);

characterized in that the breath sample is anonymised prior to evaluation (see para. 36); and

wherein the container 27 is collapsible (see fig. 1).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The other patents cited in the PTO-892 teach subject matter related to the Applicant's claims. The Examiner suggests reviewing these patents before responding to the present Office Action.

13. Applicant's amendment, filed on 13 December 2007, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAVIN NATNITHITHADHA whose telephone number is (571)272-4732. The examiner can normally be reached on Monday-Friday, 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles A. Marmor, II/
Supervisory Patent Examiner
Art Unit 3735

/N. N./
Patent Examiner, Art Unit 3735
11/07/2008